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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/845,611

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Peter Kassan

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07/30/2004

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EXAMINER

BACKER, FIRMIN

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 07/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/845,611

Applicant(s)

KASSAN ET AL.

Examiner

Firmin Backer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response to Amendment

This is in response to an amendment file on May 3rd, 2004. Claims 1 has been amended, no claim has been canceled, and no claim has been added. Claims 1-22 remain pending in the letter.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Frison et al (U.S. Patent No. 6,049,789).

3. As per claim 1, Frison et al teach a job accounting and chargeback system (*billing system, 308*) for software products (*applications subject to licensing, 210*), the system comprising: a manager (*license management system, 300*) comprising of a software product use monitoring subsystem that handles requests for and grants rights to use software products the use of which requires payment of specified license fees to one or more software product licensors the software license manager further operable to develop and which develops software product use information; a job accounting and chargeback (JACS) subsystem that develops chargeback data that is referenced to charged entities hat are separate of and unrelated to the software product

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licensors and to the specified license fees- and said job accounting and chargeback system allocates the specified license fees in accordance with predefined criteria based on the charged entities utilization for use of software or computer facilities; and a job accounting and software use intercoupling facility that intercouple the software product use information with the chargeback data in a manner that provides software-product chargeback information (*see abstract, fig 1, 2, 7, column 1 lines 48-61, 2 lines 50-4 line 46*).

4. As per claims 2, 5, 6, 13 and 14, Frison et al teach a system further including a process-data collector that develops process-related data and the job accounting and chargeback subsystem deriving identities of the charged entities from the process-related data comprises process detail records and links to event log records, including a process-to-product vendor link table (*see fig 1, 2, 3-5*).

5. As per claim 3, Frison et al teach a system in which the software-product chargeback information comprises cost information for the use of the software products and the manager is a license manager (*see abstract, fig 1, 2, 7, column 1 lines 48-61, 2 lines 50-4 line 46*).

6. As per claim 4, Frison et al teach a system in which the software-product chargeback information is referenced to software product vendors (*see fig 1, 2, 3-5*).

7. As per claims 5, 7-10, Frison et al teach a system in which the software-product chargeback information comprises process-product-link records and each such record comprises

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at least two fields include a key field pointing to a process detail record and product key field comprises a vendor id or a product id, comprising a third field, which is a link to a particular licensing session (*see abstract, fig 1, 2, 7, column 1 lines 48-61, 2 lines 50-4 line 46*).

8. As per claim 11, Frison et al teach a system further including a plurality of software clients operable with corresponding client exit routines, components of the job accounting and chargeback subsystem being present in the client exit routines (*see abstract, fig 1, 2, 7, column 1 lines 48-61, 2 lines 50-4 line 46*).

9. As per claim 12, Frison et al teach a system in which the process-related data comprises system management facility (SMF) records (*see fig 1, 2, 3-5*).

10. As per claim 15, Frison et al teach a system in which the intercoupling facility correlates the software-product chargeback information to specific product licensing sessions (*see abstract, fig 1, 2, 7, column 1 lines 48-61, 2 lines 50-4 line 46*).

11. As per claim 16, Frison et al teach a system including a facility that develops the software-product chargeback information over selected time periods (*see abstract, fig 1, 2, 7, column 1 lines 48-61, 2 lines 50-4 line 46*).

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12. As per claim 17, Frison et al teach a system including a facility that compares chargeback data against budgeted charges relative to specific software products (*see abstract, fig 1, 2, 7, column 1 lines 48-61, 2 lines 50-4 line 46*).

13. As per claims 18 and 19, Frison et al teach a system including a reporter that generates viewable reports including a data sorter, displaying selected portions of the software-product chargeback information (*see fig 1, 2, 3-5*).

14. As per claim 20, Frison et al teach a system including a facility that allocates to specific products a total cost, which cost is used by the job accounting and chargeback subsystem to develop the chargeback data (*see abstract, fig 1, 2, 7, column 1 lines 48-61, 2 lines 50-4 line 46*).

15. As per claim 21, Frison et al teach a system including a facility that measures a parameter indicative of the extent of use of different ones of the software products and the parameter being selected from the parameter group consisting of CPU time; elapsed time; number of queries to a database; number of records retrieved; and use peripherals related to the use of software products (*see abstract, fig 1, 2, 7, column 1 lines 48-61, 2 lines 50-4 line 46*).

16. As per claim 22, Frison et al teach a system in which the software products act in the system as software clients and the manager is a license manager that acts in the system as a server and including a plurality of license manager agents that execute client exit routines in response to being presented with license requests from the software clients, and further including

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a JACS client exit routine that interacts with the client exit routine of the license manager agents, in a manner such that the JACS client exit routine obtains the process-related data which is then returned to the client exit routine (*see abstract, fig 1, 2, 7, column 1 lines 48-61, 2 lines 50-4 line 46*).

Response to Arguments

17. Applicant's arguments filed May 3rd, 2004 have been fully considered but they are not persuasive.

Applicant argues that the prior art fail to teach the inventive concept disclose in claim 1 and the subsequent claims. In order for examiner to fully consider Applicant's argument, Applicant should submit an argument and point out disagreements with the examiner's contentions. Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them. Applicant further indicates that the prior art is no way related to the inventive concept cited in claim 1. Examiner respectfully disagrees with Applicant characterization of the prior art. Frison's inventive concept to a software licensing system that includes one or more licensor PPU license management system and one or more licensee communicatively coupled to each other as shown. Each licensee LMS includes one or more components that operate to grant pay-per-use licenses for software applications subject to licensing, including data collection on amount of usage licenses granted, and to monitor operational states of the pay-per-use license granting and data collection operations, including periodic reporting of state and usage license granted data to a licensor

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LMS. Each licensor LMS includes components that operate to receive, store and process state and usage license granted data for the software applications from the licensee systems, including verification of timely periodic reporting from the licensee LMS. Therefore, the Frison's inventive concept is absolutely related to the disclosure.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

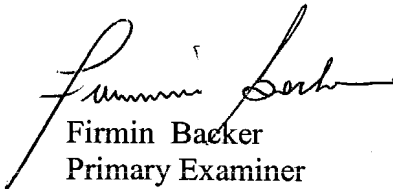
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Firmin Baeker
Primary Examiner
Art Unit 3621

July 28, 2004